

Appl. No.10/052,322  
Atty. Docket No. G-264ML  
Amdt. dated 01/16/2004  
Reply to Office Action of 10/16/2003  
Customer No. 27752

### REMARKS

#### Application Amendments

Claims 1-6 are pending in the present application. No additional claims fee is believed to be due.

Claims 7-23 have been withdrawn as a result of an earlier restriction requirement, and may be canceled upon notice of allowable subject matter.

Claim 1 has been amended to delete "hydroxyalkyl" from the group defining  $R_1$  and  $R_2$ . Support for this amendment can be found in the original claim 1 and at page 3, lines 6-18 as well as at page 22 lines 12-24 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

#### Rejection Under 35 USC 103(a) Over US Patent No. 5,993,491 to Lim et al.

Claims 1 and 2 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,993,491 to Lim et al. ("Lim"). The Examiner states that Lim discloses the use of 2-(2-hydroxyethylaminomethyl)-p-aminophenol as an intermediate in hair dye compositions. This compound is a one-carbon homolog of a compound claimed by Applicants, thus, the Examiner asserts, it would have been obvious to one of ordinary skill in the art to prepare the aminoethyl homolog because it would be expected to have similar properties to the disclosed compound. Applicants respectfully traverse the present rejection based on the following comments.

Lim does not teach or suggest all of Applicant's claim limitations and, therefore, does not establish a *prima facie* case of obviousness (MPEP 2143.03). As currently amended,  $R_1$  and  $R_2$  in Applicants' claim 1 are each independently selected from the group consisting of a *hydrogen atom and a  $C_1$  to  $C_5$  alkyl group*, or  $R_1$  and  $R_2$  together with the nitrogen atom to which they are attached form a cyclic ring as described in the claim. Although Lim discloses 2-(2-hydroxyethylaminomethyl)-p-aminophenol among a listing of several compounds suitable as intermediates in hair dye compositions, the aminoethyl homolog of this disclosed compound requires a *hydroxyethyl group* attached to the nitrogen atom of the aminoethyl group, which differs in chemical structure from compounds claimed by Applicants' present claims. Therefore, Lim fails to establish a *prima facie* case of obviousness.

Additionally, there is no suggestion or motivation for one of ordinary skill in the art to modify Lim to achieve Applicants' claimed compounds. Lim is directed to oxidative hair dye compositions comprising compounds of the class of 1-(4-aminophenyl)-2-pyrrolidinemethanols. Lim merely lists 2-(2-hydroxyethylaminomethyl)-p-aminophenol among several compounds

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suitable as intermediates in hair dye compositions and which may optionally be used in hair dye compositions along with the 1-(4-aminophenyl)-2-pyrrolidinemethanol compounds of Lim. Lim does not contemplate substituted or modified 2-(2-hydroxyethylaminomethyl)-p-aminophenol compounds, nor does Lim provide any other suggestion or motivation for one of ordinary skill in the art to modify 2-(2-hydroxyethylaminomethyl)-p-aminophenol in any way. Moreover, Lim discloses 2-(2-hydroxyethylaminomethyl)-p-aminophenol in the singular form as an individual compound, not as a broad class of several compounds. When referring to a class of compounds, Lim uses broader language, for example, "p-phenylenediamine derivatives such as..." See column 5, line 26 of Lim. Lim clearly is not teaching one of ordinary skill in the art to use a broad class of compounds when referring to 2-(2-hydroxyethylaminomethyl)-p-aminophenol. Therefore, it would not have been obvious to one of ordinary skill in the art to modify the compounds of Lim to achieve Applicants' presently claimed compounds.

Accordingly, Applicants' claims 1 and 2 are novel and unobvious over Lim.

#### CONCLUSION

In light of the amendments and remarks presented herein, it is requested that the Examiner reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-6.

Respectfully submitted,

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January 16, 2004  
Customer No. 27752